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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 09/931,836 | 08/16/2001 | Luc Desnoyers | P3030R1C1 | 5218 |
| 9157 | 7590 | 07/27/2004 | EXAMINER | |
| GENENTECH, INC. | | | JIANG, DONG | |
| 1 DNA WAY | | | ART UNIT | |
| SOUTH SAN FRANCISCO, CA 94080 | | | PAPER NUMBER | |

1646

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,836

Applicant(s)

DESNOYERS ET AL.

Examiner

Dong Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-26 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-26 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 22-26 and 33-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/24/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED OFFICE ACTION

The request filed on 24 May 2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/931,836 is acceptable, and a RCE has been established. An action on the RCE follows.

Applicant's amendment filed on 24 May 2004 is acknowledged and entered. Following the amendment, new claims 35-40 are added.

Newly submitted claims 38-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 38-40 encompass specific and non-overlapping fragments of SEQ ID NO:2. The small fragments of the claims such as residues 45-78, 137-167, and 202-221 of SEQ ID NO:2 are unlikely to share the same biological property as that of SEQ ID NO:2. Further, due to the use of "comprising" language, it cannot even be said that the search for SEQ ID NO:2 would reveal art pertaining to, for instance a polypeptide *comprising* amino acids 202-221 of SEQ ID NO:2, as the latter could be found embedded in a completely different protein. Accordingly, non-coextensive searches are required for each fragment. Additionally, the burden of search for the Office has increased with multiple sequences because of the rapid introduction of new sequences to public sequence databases.

Since applicant has received an action on the merits for the originally presented invention, a polypeptide comprising an amino acid sequence of SEQ ID NO:2, and variants thereof, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Currently, claims 22-26 and 33-40 are pending, and claims 22-26 and 33-37 are under consideration.

Inventorship

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In view of the papers filed on 24 May 2004, the inventorship in this nonprovisional application has been changed by the deletion of Dan L. Eaton, Audrey Goddard, Paul J. Godowski, Austin L. Gurney, James Pan, Timothy A. Stewart, Colin K. Watanabe and Zemin Zhang.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Declaration

The declaration filed on 24 May 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Piddington reference, US 6,521,233 B1.

The Piddington reference is a U.S. patent that *claims* the rejected invention (see claims 2, 3 and 13 of the patent). An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 22-26, 33 and 34 remain rejected, and the new claims 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Piddington et al., US 6,521,233 B1, for the reasons of

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record set forth in the previous Office Action, paper No. 12, mailed on 20 August 2003, at page 2.

Conclusion:

No claim is allowed.

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Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Dong Jiang, Ph.D.
Patent Examiner
AU1646
7/20/04

A handwritten signature in cursive script that reads "Lorraine Spector". The signature is written in black ink and is positioned in the lower right quadrant of the page.

**LORRAINE SPECTOR
PRIMARY EXAMINER**